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09/987,076	11/13/2001	Jiro Senda	Q66742	6567
7590 09/30/2008 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213				
EXAMINER GARCIA, GABRIEL I				
ART UNIT		PAPER NUMBER		
2625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/987,076

## Applicant(s)

SENDA, JIRO

## Examiner

GABRIEL I. GARCIA

## Art Unit

2625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 8 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 8 and 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

1. This application has been examined, Claims 1,4,5,8 and 17-25 are pending in this application.
2. Applicant's arguments, see page 8 of paper, filed 6/18/08, with respect to Nihei "634 have been fully considered and are persuasive. . Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of \*\*\*.  
rejection of pending claims has been withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,4,5,8 and 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al. (6,507,415) in view of Yomamoto (6,061,150) .

Regarding claim 1, Toyoda et al. discloses an image transmitting device (see Figs. 1 and 20) comprising combining process means (9) for generating a composite image by joining a plurality of original images (e.g. abstract, claim 1); storing means (6) for storing the composite image generated by the combining process means and the

original images that the composite image comprises together with corresponding combining data (10b) required for generating the composite image (see fig. 6, clearly any image can be stored and later can be further process and combine with another image) , and selection process means for executing a selection process that outputs one or more of the composite image, original images, or combining data as output data to an output destination device specified as the destination for image transmission (e.g. col. 18, lines 11-46) . Toyoda et al. fails to teach selection means further comprises: selecting output data based on predetermined based on the attributes of the output destination. However, Yomamoto (in the same filed of endeavor "data processing") teaches that it is well known in the art at the time of the invention to make a selection of output data based on predetermined attributes of the output destination (e.g. col. 25, lines 18-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system of Toyoda et al, with the means to select output data based on the attributes of the out destination as taught by Yomamoto because of the following reasons: 1) will allow the system of Toyoda et al. to send the selected combined image(s) to a destination that has attributes or features required to process the created composite image; and 2) of the destination transmit the combined images into different destination having the features or attributes needed to print or process the combined image, and 2) will allow the system of Toyoda to send the processing job to a destination that satisfies the predetermined conditions as suggested by Yomamoto in col. 2, lines 17-31).

With regard to claim 4, the combination of Toyoda et al. and Yomamoto disclose the image transmitting device having the selection process discussed above in claim 1 and further Yomamoto further teaches that the selection process means executes the selection process based on user specifications (e.g. col. 15, lines 41-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system of Toyoda et al, with the means to select output data based on user specifications as taught by Yomamoto because of the following reasons: 1) will allow the system of Toyoda et al. to send the selected combined image(s) to a destination that has specification or features required to process the created composite image; and 2) of the destination transmit the combined images into different destination having the features or specifications needed to print or process the combined image, and 2) will allow the system of Toyoda to send the processing job to a destination that satisfies the predetermined conditions as suggested by Yomamoto in col. 2, lines 17-31).

With Regard to claim 5, the limitations of claim 5 are covered by the limitations of claim 1 above.

With regard to claim 8, the combination of Toyoda et al. and Yomamoto disclose the image transmitting method discussed above in claim 5, and Yomamoto further teaches that the selection process in the selection process step is executed based on user

specifications (see Figs. 6-21, column 5, lines 11-49, and column 7, line 21-column 8, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the system of Toyoda et al, with the means to select output data based on user specifications as taught by Yomamoto because of the following reasons: 1) will allow the system of Toyoda et al. to send the selected combined image(s) to a destination that has specification or features required to process the created composite image; and 2) of the destination transmit the combined images into different destination having the features or specifications needed to print or process the combined image, and 2) will allow the system of Toyoda to send the processing job to a destination that satisfies the predetermined conditions as suggested by Yomamoto in col. 2, lines 17-31).

With regard to claim 17, Toyoda et al discloses wherein the election process means executes the selection process to selectively output one of the original images and combining and composite images based on properties of the output destination device (reads on fig. 6, which clearly depicts how any image can be stored and later can be further process and combine with another image to create a composite image) .

With regard to claim 18, Toyoda et al discloses a storage means comprises a single physical memory (reads on the fig. 1, item 3 or 6).

With regard to claim 19, Toyoda et al discloses a storage means is a harddisk (reads on item 503a).

With regard to claim 20, Toyoda et al. discloses wherein the images are obtained from

a scanner (1). Toyoda et al. is silent as to the scanner being able to scan medical images. It would have been obvious to one of ordinary skill at the time of the invention to replace the scanner of Toyoda et al. with a medical scanner that allows the user(s) to scan medical images, therefore, allowing the user to combine medical images with other images, improving the versatility of the system as taught by the combination of Toyoda et al. and Yomamoto.

With regard to claim 21, the limitations of claim 21 are covered by the limitations of claims 1 and 17 above.

With regard to claims 22-25, the limitations of claims 22-25 are covered by the limitations of claims 1 and 17 above. (clearly the ability to combine images can result in the storing of combined original images, and taking this created combined image and combining it with another image).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

/Gabriel I Garcia/

Primary Examiner, Art Unit 2625

**Gabriel I. Garcia**  
**Primary Examiner**  
**September 23, 2008**